

PRELIMINARY AMENDMENT
Rule 1.53(d) CPA of U.S. Appln. No. 09 317,986

REMARKS

By way of this Continued Prosecution Application, the Examiner will see that claims 19 and 20 withdrawn from consideration in the Action of September 24, 2001, are presented for the Examiner's consideration along with the other claims active at that time.

Should the Examiner still view claims 19-20 as directed to an invention that is independent or distinct from the invention originally claimed for the reasons set forth in the Action of September 24, 2001, the Examiner is requested to contact the undersigned so that if the Examiner maintains his position regarding constructive election, applicants will have the option to elect claims 19-20 or 1, 6, 8, 10 and 18.

Applicant's respectfully request the Examiner to consider all claims pending (except claims 11-18), namely claims 1, 6, 8, 10-18 and claims 19-20 in a first Action since applicants respectfully submit that claims 19-20 are proper dependent claims and, as applicants have earlier argued, to follow the Examiner's position to its logical conclusion, any time claims are added after a first rejection which are properly dependent from an independent claim, a "distinct species" position can be taken. Certainly this unfair to applicants.

Applicants have the following comments on the remarks which the Examiner advanced in the Advisory Action of March 12, 2002.

First, the Examiner's position appears to be that Fukata actually teaches a relatively narrow range for the non-Newtonian coefficient "which happens to anticipate applicants' claimed range". Hereafter, ranges will be discussed without reference to the non-Newtonian coefficient simply to avoid using extra words since in context the meaning of the ranges is clear.

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The claimed range is 1.05-1.20. At columns 3-4, lines 65-10, the range given in Fukata is $0.9 < n < 3.0$, preferably $0.9 < n < 2.0$. While these ranges may include the ranges claimed in the present application, they are not the same as those claimed in the present application, nor do the ranges claimed in the present application "touch" the ranges in Fukata at the extremes of Fukata.

Applicants would not disagree with the Examiner regarding anticipation if Fukata disclosed a value which fell precisely within the claimed range of 1.05-1.20. However, this is not the case. What Fukata does, and applicants have urged this range in Fukata is extremely large, is disclose a range that includes or encompasses applicants' claimed range.

In situations involving virtually little or no selectivity, even though a reference does not exemplify a species falling within the area of overlap, anticipation may be found.

On the other hand, where a prior art disclosure is extremely broad, a *prima facie* case of obviousness may not even arise.

Between these two extremes is the situation where the overlap would have rendered the claimed invention *prima facie* obvious.

In the present instance, it might be argued that Fukata specifically exemplifies values of 0.9, 2.0 and 3.0. All of these values are outside of the range claimed herein.

Applicants respectfully submit that in this situation, given the breadth of the Fukata disclosure and the narrowness of applicants' claims, that a proper *prima facie* case of obviousness has not been established.

If the Examiner disagrees, applicants respectfully request the Examiner to call counsel at the later given telephone exchange so that this issue may be discussed.

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Thus, applicants do not admit that Fukata specifically teaches the non-Newtonian coefficient range claimed herein.

With respect to Example 4 in Fukata, for reasons which have been advanced by applicants during earlier prosecution, applicants respectfully submit that Fukata Example 4 involving a branched PPS polymer provides insufficient information regarding the non-Newtonian constant, so that one of ordinary skill in the art would not view Example 4 as supporting an anticipation rejection of the claims herein.

Finally, with respect to the Examiner's position regarding combining the non-Newtonian range disclosure in Fukata with Example 4 in Fukata, for the reasons advanced above even if this combination is made, applicants respectfully submit that the Examiner's conclusion in the Advisory Action of "completely anticipated" is incorrect.

With respect to combining Fukata with Harwood/Ikeda/Auerbach, as phrased in the Action of September 24, 2001, the rejection is over Harwood, Ikeda or Auerbach, each in view of Fukata.

As earlier argued, applicants submit that Fukata does not teach the non-Newtonian constant of the present invention as claimed.

Accordingly, while applicants do agree with the Examiner's test for combining references being that it is what the combination as a whole would suggest to one of ordinary skill in the art, applicants respectfully submit that even if the combination is made, one is still lacking the non-Newtonian constant of the present invention as claimed.

With respect to the rejection further in view of Senga, for the reasons advanced in the RESPONSE of February 25, 2002, applicants respectfully submit that considering these specific

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limits of claims 6, 8 and 10, Senga does not remedy the defects of Harwood Ikeda or Auerbach in view of Fukata, and for that reason the rejection over Senga is improper.

New claim 21 is added finding basis in the working examples.

Respectfully submitted,



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APPENDIX

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Claims 21 is added as a new claim.